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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,322	04/07/2006	Andreas Koster	PIERBU0018	7463
24203 7590 11/17/2008				
GRIFFIN & SZIPL, PC				
SUITE PH-1				
2300 NINTH STREET, SOUTH				
ARLINGTON, VA 22204				
EXAMINER				
HO, HA DINH				
ART UNIT		PAPER NUMBER		
3655				
MAIL DATE		DELIVERY MODE		
11/17/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/595,322

Applicant(s)

KOSTER ET AL.

Examiner

HA D. HO

Art Unit

3655

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-6 and 9 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 7 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. This Office Action is responsive to Amendment filed 9/16/08. Claims 1-9 are currently pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Lang et al (US 6,007,446).

Lang et al teaches an actuating device (see Fig. 3) comprising a drive unit comprising an electric motor 8, which motor is arranged in a housing 1 and drives a drive shaft (i.e., the shaft that has the sun gear 21 integrally mounted on); a gear unit comprising a drive gear 21 arranged on the drive shaft at least in a rotationally fixed manner (note gear 21 is integral with that shaft), one or more planetary gears (23, 32), each planetary gear comprising a double gear having a larger gear wheel 23 and a smaller gear wheel 32 supported on an axle 29 in a fixed position (i.e., pin 29 is fixed to the web under-piece 30) and so that the planetary gear can pivot, and an internally toothed gear or gear segment 36 that is arranged on an output shaft 50 in an at least rotationally fixed manner, wherein the drive gear 21 in a first gear stage meshes with at least one planetary gear 23, whereby the drive gear 21 drives the larger gear wheel 23 of the double gear,

and the smaller gear wheel 32, which faces a direction of an output side, in a second gear stage meshes with the internally toothed gear or gear segment 36, so that the output shaft 50 can be driven via the two gear stages; and a cover 2 fixed to the housing 1 of the drive unit and the outside of the gear unit, and arranged so that a bearing of the output shaft is arranged in the cover (note the extension 41 is supported in a bearing shell 43, which is an extension of the housing upper-piece 2, see col. 3, lines 8-9).

4. Claims 1, 2, 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Mistic (US 2,499,928).

Mistic teaches an actuating device (see Fig. 2) comprising a drive unit comprising an electric motor (28, 38), which motor is arranged in a housing 10 and drives a drive shaft 60; a gear unit comprising a drive gear 62 arranged on the drive shaft 60 at least in a rotationally fixed manner, one or more planetary gears (79, 80), each planetary gear comprising a double gear having a larger gear wheel 79 and a smaller gear wheel 80 supported on an axle 76 in a fixed position and so that the planetary gear can pivot, and an internally toothed gear or gear segment 72 (note gear segment is defined as in axial direction) that is arranged on an output shaft 67 in an at least rotationally fixed manner, wherein the drive gear 62 in a first gear stage meshes with at least one planetary gear 79, whereby the drive gear 62 drives the larger gear wheel 79 of the double gear, and the smaller gear wheel 80, which faces a direction of an output side, in a second gear stage meshes with the internally toothed gear or gear segment 72, so that the output shaft 67 can be driven via the two gear stages; and a cover 63 fixed to the housing 10 of the drive unit and

the outside of the gear unit, and arranged so that a bearing 66 of the output shaft 67 is arranged in the cover.

Regarding claim 2, wherein said at least one planetary gear (79, 80) of said gear unit features only one planetary gear, and further comprising a motor end shield 56 which supports said axle 76 of said planetary gear and to which said axle is fixed, and still further comprising a gear-side bearing 58 of said drive shaft 60 arranged in the shield 56, wherein the shield is arranged to be firmly connectable to said housing 10 of said electric motor.

Regarding claims 7 and 8, wherein the output shaft 67 has only a single bearing 66, the bearing 66 being arranged in the cover 67.

Allowable Subject Matter

5. Claims 3-6 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

6. Applicant's arguments filed 9/16/08 have been fully considered but they are not persuasive.

7. Applicant argues that Lang does not disclose or suggest the "drive shaft" because the axle 46 does not rotate, and Lang does not disclose or suggest the "drive gear arranged on the drive shaft . . . in a rotationally fixed manner" of claim 1. Note that the interpreted drive shaft is not the axle shaft 46. Rather, the interpreted drive shaft is the one that has the gear 21 integrally

provided there on the left end and the gear 22 integrally provided there on the right end. That drive shaft rotates about the fixed axle 46, and **“the drive gear 21 is arranged on that drive shaft in a rotationally fixed manner”** as required by claim 1.

8. Applicant argues that Lang does not disclose or suggest a “planetary gear . . . supported on an axle in a fixed position” as required by claim 1 because the axle 29 is not “in a fixed position and it revolves around the sun gear 21. Note that the recitation **“an axle in a fixed position”** is so broad that it can be interpreted as that the axle is fixed to and non-rotatable relative with an element. Note that Lang shows the axle 29 is fixed to and non-rotatable relative with the web under part 30. Claim 1 does not require that the axle is in a fixed position **and** does not revolve around a sun gear.

9. Applicant argues that Mistic fails to disclose or suggest the “internally toothed gear or gear segment that is arranged on an output shaft in an at least rotationally fixed manner” of claim 1 because Mistic’s gear 72 is externally toothed, **not internally toothed**. Note that claim 1 recites “an internally toothed gear **or** gear segment.” Therefore, the reference is not necessary to show both, i.e., an internally toothed gear **and** gear segment. In this case, Mistic’s gear 72 is a gear segment (note gear segment is defined as in axial direction, not radial direction).

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

Art Unit: 3655

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Communication

11. Submission of your response by facsimile transmission is encouraged. The fax phone numbers for the organization where this application or proceeding is assigned are **(571) 273-8300**. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see M.P.E.P. 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check should not be submitting by facsimile transmission separately from the check. Responses submitted by facsimile transmission should include a Certificate of Transmission (M.P.E.P.. 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to
the Patent and Trademark Office on _____

(Date)

Typed or printed name of person signing this certificate:

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and M.P.E.P.. 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the

Art Unit: 3655

processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HA D. HO whose telephone number is **571-272-7091**. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor can be reached on **571-272-7095**.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/HDH/
(571) 272-7091
November 15, 2008

/Ha D. Ho/
Primary Examiner, A.U. 3655